

REMARKS/ARGUMENTS

The foregoing amendment and the following arguments are provided to impart precision to the claims, by more particularly pointing out the invention, rather than to avoid prior art.

35 U.S.C. § 112, second paragraph, Rejections

Examiner rejected claims 6 and 8 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has amended claim 6 to overcome this rejection. Claim 8 has been cancelled.

35 U.S.C. § 102(b) Rejections

Examiner rejected claims 5 and 7-8 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,583,474 (hereinafter "Mizoguchi").

Claims 5 and 7 include a limitation of a first magnetic layer over a first dielectric layer including a slot having a first shape and a conductor over a second dielectric layer having a second shape, the first shape is independent of the second shape. Mizoguchi does not teach such a limitation, and as a result, does not anticipate claims 5 and 7. Instead, Mizoguchi teaches a magnetic layer having a spiral groove which extends exactly along the spiral conductor of a coil (Col. 20, lines 51-53). Therefore, the groove taught by Mizoguchi follows the conductor. As a result, claims 5 and 7 are not anticipated by Mizoguchi.

As will be explained below, there is no motivation to combine Mizoguchi and Mandai. Therefore, claims 5 and 7 would also be patentable over a combination of Mizoguchi and Mandai.

35 U.S.C. § 103(a) Rejections

Examiner rejected claim 6, is rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,583,474 (hereinafter "Mizoguchi") in view of U.S. Patent 4,543,553 (hereinafter "Mandai").

Mandai does not suggest a combination with Mizoguchi. Mizoguchi teaches a planar inductor having several layers including a spiral planar coil (Col. 10, lines 30-35). As can be seen in Figure 5 of Mizoguchi, the coil has two ends and forms a complete electrical path. Conversely, the conductor taught by Mandai is not planar (see Figure 5), and the through holes taught by Mandai are included *only* to facilitate electrical connections between the magnetic layers to create the conductor (Col 4, lines 3-13). When the structure taught by Mandai is complete, the resulting conductor meanders throughout the several layers of magnetic material, using the through holes to create electrical interconnects between layers. The spiral conductor of Mizoguchi is complete before the assembly of the layers, and there would be no reason to add the through holes of Mandai to form more electrical connections. Further, there is only one conductor taught by Mizoguchi, so Mizoguchi would be unable to form more electrical connections through the through holes if they were provided. Since Mizoguchi teaches a planar conductor, there would be no suggestion for a combination, as the through holes as used by Mandai would not be necessary to form electrical connections when using a planar conductor, since the conductor already forms a continuous path. As a result, there is no suggestion or motivation to combine the two references, and claim 6 is patentable over Mizoguchi and Mandai.

Claim 6, as amended, includes a limitation of a conductor over the second dielectric layer, the conductor having a first shape, wherein the magnetic layer defines at least one slot, the slot having a second shape independent of the first

shape of the conductor. Further, claim 6 includes a limitation where the second dielectric layer is over the magnetic layer. Neither Mizoguchi nor Mandai teach such a limitation, and as a result, claim 6 is patentable over Mizoguchi and Mandai.

Specifically, the Examiner admits that Mizoguchi does not teach a slot. Mandai teaches several magnetic layers, each including a through hole to facilitate electrical connections. The magnetic layers also include L-shaped conductive patterns formed on their surfaces (Col. 3, lines 36-39). When the magnetic layers are compressed, a single, continuous conductor is formed throughout the layers (See Figures 3 and 5). Since the resulting conductor runs throughout the entire structure, and *through the magnetic layers*, Mandai does not teach a conductor over a magnetic layer. As a result, claim 6 is patentable over Mizoguchi and Mandai.

Further, the through holes as taught by Mandai allow the magnetic layers to deform and form electrical connections (Col. 4, lines 3-10). As can be seen in Figure 3, the through holes will be filled by magnetic and other layers when the structure is pressed together. Therefore, it is impossible to predict a shape of the hole after the layers are pressed together. Since the shape of the holes after the compression is complete is not in any way predetermined, it cannot be said that Mandai teaches where a conductor has a first shape, and a slot in a magnetic layer having a second shape independent of the first shape. As a result, claim 6 is patentable over Mizoguchi and Mandai.

Claim 9 depends from claim 7, and as a result includes all the limitations of claim 7. Since claim 7 is not anticipated by Mizoguchi, claim 9 is patentable over Mizoguchi and Mandai.

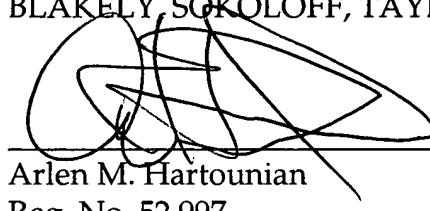
CONCLUSION

Applicant respectfully submits the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call Arlen M. Hartounian at (408) 720-8300.

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due.

Respectfully submitted,

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